Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-5, 8, and 17 are pending in the application, with claim 1 being the independent claim. Claims 6, 7 and 9-16 were withdrawn from consideration by the Examiner. Support for new claim 17 may be found on page 51, lines 19-22, of the above captioned application. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objections to the Claims

The Examiner has required correction of claim 1 so that it will start with the article "A" and correction of claims 2-5 so that each of these claims will start with "The." Claims 1-5 have been amended accordingly and, thus, the objections to claims 1-5 have been accommodated.

Rejections under 35 U.S.C. § 103

The rejection of claims 1-5 and 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 01/74770A1 ("Ruther") is respectfully traversed.

The Examiner is of the opinion that the compounds of the present invention would have been obvious in light of Ruther, citing 40-year old case law, *In re Herr 134* USPQ 176 (1967). Applicants respectfully submit that the Examiner's conclusion is based on an over-generalization of the case law, and ignores more recent controlling decisions. Specifically,

the courts have recently addressed the requirements for a determination of obviousness in the chemical compound area. See *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. Sup. Crt. 2007); *Takeda v. Alphapharm*, 492 F.3d 1350 (Fed. Cir. 2007); *Takeda Chem. Indus. v. Mylan Labs.*, 549 F.3d 1381 (Fed. Cir. 2008); *Eisai Co., Ltd. v. Teva Pharms. USA, Inc.*, 533 F.3d 1353 (Fed. Cir. 2008). Under these modern decisions, an Examiner must identify a prior art compound as a "lead compound" and provide rationale to modify that lead compound to make the claimed compounds. The Examiner has, however, provided no explanation why a person of ordinary skill in the art would select I-1-b-3 from Ruther as a starting point or why one would replace a methyl with an ethyl in such a position. In other words, a general motivation is simply not enough of an argument to establish a valid case of *prima facie* obviousness. Accordingly, claims 1-5 and 8 are not *prima facie* obvious in light of Ruther and the rejection should be withdrawn.

Furthermore, Applicants enclose a first declaration under 37 C.F.R. § 1.132 which recites the unexpected superiority of the claimed invention over Ruther. This declaration by Dr. Wolfgang Thielert recites data from two pesticidal tests which compare the claimed invention to Example I-1-b-3 of Ruther. Specifically, an illustrative compound of the present invention (wherein Y is methyl) has 90% efficacy in the killing of aphids (*Myzus persicae*, or MYZUPE) whereas Example I-1-b-3 of Ruther (wherein Y is hydrogen) gave 0% efficacy as compared to untreated plants. First Declaration at page 3. Furthermore, this declaration demonstrates that this compound of the present invention has 70% efficacy in

the killing of spider mites (*Tetranychus urticae*, TETRUR), whereas Example I-1-b-3 of Ruther gave 0% efficacy, compared to untreated plants. *Id.* at page 3.

Accordingly, this declaration demonstrates the surprisingly superior efficacy of the compounds of the claimed invention. Applicants therefore respectfully submit that the above obviousness rejection is rendered moot and should therefore be withdrawn.

The rejection of claims 1-5 and 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,462,913 ("Fischer") in view of Wolff, M.E., *Burger's Medicinal Chemistry 4th Ed. Part 1*, Wiley: New York, 1979, 336-337 ("Wolff"), is respectfully traversed.

The Examiner is of the opinion that the claimed compounds of the present invention would have been obvious in light of Fischer, in view of Wolff, citing a case from 1950, *In re Henze* 85 USPQ 261 (1950).

As above, Applicants submit that after *KSR* an Examiner should be following the law as governed by the *Eisai* and *Takeda* decisions. In *Takeda,* the court made clear that in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound.

The Examiner has asserted that a compound disclosed in Fischer (Example Id-1) differs from the substitution of a methyl for an ethyl of the rejected claims. Additionally, the Examiner has suggested that since Wolff teaches "that the addition of alkyl groups to

active pharmacological agents often improves activity," it would have been obvious to modify Id-1 to arrive at a compound of the current application. Office Action, page 7.

This analysis is entirely improper, in multiple ways. First, the Examiner has failed to provide any rationale why one of ordinary skill in the art would choose the compound Id-1 of Fischer as a lead compound. Fischer recites hundreds of compounds, yet the Examiner has selected this one compound without providing any rationale for this selection. Second, the broad statement the Examiner gleans from Wolff "that the addition of alkyl groups to pharmacological agents often improves activity," is not sufficient rationale to modify this compound in this position and in this way.

Furthermore, Applicants enclose a second declaration under 37 C.F.R. § 1.132 which recites the unexpected superiority of the claimed invention over Fischer. This second declaration by Dr. Wolfgang Thielert recites data from emergence testing which compares the current invention to European Patent Publication No 0596298 (patent family member equivalent of Fischer) and European Patent Publication No 1280770 (patent family member equivalent to Ruther). (Second Declaration, pages 1-5). Specifically, an illustrative compound of the present invention (wherein the 2-phenyl position is ethyl; the 7th compound on page 3 of the second declaration) gave 90% efficacy in the killing of TETRUR, whereas the Fischer compound (wherein the 2-phenyl position is methyl; the 8th compound on page 3 of the second declaration) gave 0% efficacy, compared to untreated plants.

Accordingly, this declaration demonstrates the surprisingly superior efficacy of the compounds of the claimed invention. Applicants therefore respectfully submit that the above obviousness rejection is rendered moot and should therefore be withdrawn.

Provisional Obviousness-Type Double Patenting Rejection

The rejection of claims 1-5 and 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable on the ground of obviousness-type double patenting over claims 1-3 of Fischer in view of Wolff, is respectfully traversed.

The Examiner has rejected claims 1-5 and 8 for nonstatutory double patenting for the same reasons as recited above for the second 103(a) rejection. Therefore, Applicants submit that the arguments above render this rejection moot and hereby request that the rejection be withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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